

REMARKS/ARGUMENTS

This Amendment is in response to the Office Action dated June 7, 2007. Claims 1-14 are pending in the present application. Claims 1-14 have been rejected. Claims 1, 5, 8, and 11 have been amended address a §112 rejection in order to place the claims in condition for allowance. Support for the amendments to the claims is found throughout the specification, and in particular, on page 4, lines 11-19. Applicants respectfully submit that no new matter has been presented. Claims 1-14 remain pending. For the reasons set forth more fully below, Applicants respectfully submit that the claims as presented are allowable. Consequently, reconsideration, allowance, and passage to issue are respectfully requested.

Rejections Under 35 U.S.C. §112

Claims 1-14 are rejected under 35 U.S.C. §112, 2nd paragraph.

Examiner Stated:

Claims 1-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) content subject matter, i.e., the telephone provides a three-way call recited on claims 1 (lines 5-6), 5 (lines 3-4), 8 (line 5) and claim 11 (lines 4-5), which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention...

From the citation “the called party at phone 100” of the above disclosure, it is not clear whether the called party at phone 100 is making an outgoing call or receiving an incoming call. It is noted that a “called party” in this paragraph “the called party at phone 100 performs a flash-hook (i.e. goes off hook), which initiates three-way call through line 102 of the voice mailbox 4”, the called party at telephone 100 and the calling party at

telephone 1”, via step 304”. This sentence is not clear neither. Is the called party at phone 100 already in conversation with the voice mailbox before generating the claimed three-way call? How is the “three-way call” being generated that leads to connect to three parties? Is a dedicated number being dialed? From “Newton telecom Dictionary” 19th Edition, the standard definition of Three-way call is “A local phone company feature that allows a phone user to add another user to an existing conversation and have a three party conference call”. The definition states that it is the phone company with the switching system to PROVIDE a three-way call and bridge (JOIN) three parties together in the conference call. The examiner needs clarification from the applicant about support of the definition of “Three-way call” in the original specification. It is because, the original specification fails to support such definition.

Examiner has problem to match the claimed “the telephone provides a three-way call” to the disclosed “the telephone 100 performs a flash-hook (i.e. goes off hook), which initiates three-way call” and “When the voice mailbox 4” picks up again, the telephone joins the three parties”. It is not clear as to whether the telephone is providing any “three-way call” or the telephone is just outpost an ordinary call such that the call will be bridged with the other two parties by the switch. Since the telephone didn’t receive any call from either the calling party or the voice mailbox, there is no way for the called party’s terminal to join the three parties. Applicant needs to provide support and explain to the “telephone provides a three-way call” and the “telephone joins the three parties” features.

Regarding the feature of bridging calls by a telephone terminal, such feature was very old (see Fuller et al. cited in Form 892). If the claim would like to recite the telephone terminal generates a second call to the voice mailbox after the first call routed to the voice mailbox and joins/bridges the first call and the second call together inside the telephone terminal; however, the original specification does not teach such feature because the specification fails to disclose as to how the first call is related to the telephone terminal. The first call never connected the telephone terminal. How can the telephone terminal join the two calls together? ...

Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the phrase “the call” in line 7 is indefinite. There are two different calls in the claim. One call is a call from a calling party and another is a three-way call. It is unclear which call is being referred by the phrase.

Claims 5, 8 and 11 are rejected for the same reasons as discussed above with respect to claim 1.

Applicants respectfully submit that claims 1, 5, 8, and 11, as amended, comply with 35 U.S.C. 112, second paragraph. With regard to the phrase “called party,” the Examiner stated that is not clear whether the called party is making an outgoing call or receiving an incoming call. Applicants respectfully submit that the called party is the party being called. Applicants believe that the adjective “called” clearly identifies the called party as the intended recipient of a call. Similarly, the adjective “calling” clearly identifies the calling party as the party that makes the call to the called party. Furthermore, the claim language recites “a telephone for receiving the call from the calling party.” Applicants believe that it is sufficiently clear that the telephone is the called party’s telephone, not the calling party’s telephone. Furthermore, page 4, lines 11-19 states “the called party at telephone 100.” Applicants respectfully submit that it is clear that the called party at the telephone is the intended recipient of the call and that the called party’s telephone is for receiving a call from the calling party.

The Examiner also requested clarification with regard to the section in the specification that states that “the telephone 100 performs a flash-hook (i.e., goes off hook), which initiates three-way call through line 102 of the voice mailbox 4”, the called party at telephone 100 and the calling party at telephone 1”, via step 304.” The Examiner asked, “Is the called party at phone 100 already in

conversation with the voice mailbox before generating the claimed three-way call? Page 4, lines 11-19, states:

called party at telephone 100 sets voice mail to pick up after a predetermined number of rings, in this case, two rings, via step 302. Next, the "the telephone 100 performs a flash-hook (i.e., goes off hook), which initiates three-way call through line 102 of the voice mailbox 4", the called party at telephone 100 and the calling party at telephone 1", via step 304. When the voice mailbox 4" picks up again, the telephone joins the three parties (calling party at telephone 1", voice mailbox 4", and called party at telephone 100), via step 306.

Accordingly, the telephone 100 would have made a communication with the voice mailbox before the three-way call in order to set the voice mailbox to pick up after a predetermined number of rings. However, the specific time before the actual three-way call that the telephone is in communication with the voice mailbox is not being claimed.

The Examiner also asked, "How is the "three-way call" being generated that leads to connect to three parties?" Page 4, lines 1-11, of the specification states:

telephone 100 allows the voice mail screening to take place.

Further, the telephone 100 would include an algorithm therewithin for causing the telephone 100 to set up a three-way call to allow for

the voice mail screening operation. The algorithm is preferably implemented using a software on a chip.

Accordingly, the telephone has an algorithm that causes the telephone to set the three-way call. However, the specific implementation of the algorithm is not being claimed.

The Examiner also asked, "Is a dedicated number being dialed?" Applicants are unclear as to what this question means. Whether the number being dialed by the calling party is a dedicated number is not being claimed. The specification does not mention any specific implementations that involve a dedicated number being dialed nor is a dedicated number being claimed.

The Examiner also requested clarification regarding support of the definition of a three-way call in the original specification, stating that the original specification fails to support such a definition. Applicants respectfully disagree that the specification fails to define a three-way call. Page 4, lines 11-19, of the specification states:

the telephone 100 performs a flash-hook (i.e., goes off hook), which initiates three-way call through line 102 of the voice mailbox 4", the called party at telephone 100 and the calling party at telephone 1", via step 304. When the voice mailbox 4" picks up again, the telephone joins the three parties (calling party at telephone 1", voice mailbox 4", and called party at telephone 100), via step 306.

Cleary, the three-way call joins three parties, where the three parties include the calling party at telephone 1", the voice mailbox 4", and the called party at telephone 100.

The Examiner also requested clarification as to how the telephone can perform a flash-hook, which initiates a three-way call, provide a three-way call, and join the three parties. Page 4, lines 11-19, of the specification describes that the "telephone 100 performs a flash-hook." This is a step that initiates the three-way call. This is not inconsistent with the step where the "telephone joins the three parties" to provide the three-way call. However, what is claimed is a combination of "a switching system for receiving a call from a calling party; a voice mailbox coupled to the switching system for receiving the call if a called party does not answer the call; and a telephone for receiving the call from the calling party, wherein the telephone provides a three-way call between the calling party, the called party, and the voice mailbox, wherein the telephone bridges the call between the calling party and the voice mailbox." Furthermore, Figure 3 of the specification shows that the three parties are joined at the switch. Page 4, lines 1-11, states that the telephone includes "an algorithm therewithin for causing the telephone 100 to set up a three-way call to allow for the voice mail screening operation." Page 4, lines 11-19, of the specification states that the telephone "performs a flash-hook," which initiates the three-way call, and the "telephone joins the three parties." Accordingly, by controlling the three-way call, the telephone provides the three-way call.

The Examiner rejected claims 1-14 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicants regard as the invention. The Examiner stated that the phrase “the call” in line 7 is indefinite, and that it is unclear which call is being referred to by the phrase. In response, claims 1, 5, 8, and 11 have been amended to address the rejection. Specifically, the words “three-way” have been inserted before the term “call.” Support for the amendments to the claims is found throughout the specification, and in particular, on page 4, lines 11-19.

Applicants respectfully submit that claims 1, 5, 8, and 11, as amended, now comply with 35 U.S.C. §112, second paragraph. Claims 2-4, 6-7, 9-10, and 12-14 depend from claims 1, 5, 8, and 11. Applicants respectfully submit that claims 2-4, 6-7, 9-10, and 12-14 overcome the rejection for at least the same reasons as claims 1, 5, 8, and 11.

Rejections Under 35 U.S.C. §102

Claims 1-14 are rejected under 35 U.S.C. §102(e) as being anticipated by Cannon et al. (U.S. Patent No. 6,639,972) and under 35 U.S.C. §102(b) as being anticipated by Foladare et al. (U.S. Patent No. 5,960,064).

Examiner Stated:

Claims 1-14 are rejected as best understood in light of the 35 U.S.C. 112, first paragraph and second paragraph rejections under 35 U.S.C. 102(e) as being anticipated by Cannon et al. (U.S. Patent 6,639,972).

Regarding claims 1, 5, 8 and 11, Cannon teaches a telephone system has

a switching system for receiving a call from a calling party (col. 1, lines 33-41) and

a voice mail system [i.e., voice mailbox] coupled to the switching system for receiving the call if a subscriber [i.e., called party] does not answer the call (fig. 1, step 12; col. 1, lines 33-41).

Further, Cannon teaches a telephone for receiving the call from the calling party (col. 1, lines 33-41), by leaving the called party's telephone handset going off-hook and joins the caller's talk path (col. 5, lines 8-10, 18-22), teaching of Cannon reads on the claimed "provides a three-way call between the calling party, the called party, and the voice mailbox". It is because, the examiner interprets this limitation as providing call connection from the called party to the voice mailbox and that call connection is bridged to the calling party's call by forming a 3-way call and Cannon teaches such feature on col. 5, lines 8-10, 18-22.

Cannon further teaches that the called party's telephone is capable of screening the calling party when the calling party is coupled to the voice mailbox (fig. 1, step 17, fig. 2, step 45)...

Claims 1, 5, 8 and 11 are rejected as best understood in light of the 35 U.S.C. 112, first paragraph and second paragraph rejections under 35 U.S.C. 102(b) as being anticipated by Foldare et al. (U.S. Patent 5,960,064).

Regarding claims 1, 5, 8 and 11, Foldare teaches a telephone system has a switching system for receiving a call from a calling party (abstract; col. 2, lines 13-16, col. 8, lines 19-22) and

Foldare further teaches a voice messaging system [i.e., voice mailbox] coupled to the switching system for receiving the call if a called party does not place a return telephone call after expiration of a predetermined time period (abstract; fig. 1; col. 2, lines 21-23, col. 8, lines 24-48). Since the called party does not return the telephone call within the predetermined time period, it is clear that the called party does not answer the call.

Foldare further teaches a telephone for receiving the call from the called party, wherein the telephone provides a three-way call between the calling party, the called party, and the voice mailbox, wherein the telephone bridges the call between the calling party and the voice mailbox (col. 2, lines 23-30, col. 8, lines 40-57).

Foldare further teaches wherein the called party's telephone is capable of screening the calling party when the calling party is coupled to the voice mailbox (col. 2, lines 23-30, col. 8, lines 59-62).

Response to Arguments

Regarding claims 1, 5, 8 and 11, the Applicant argues on pages 8-9 that Cannon does not teach or suggest the telephone, "wherein the telephone provides a three-way call between the calling party, the called party, and the voice mailbox, wherein the telephone bridges the call between the calling party and the voice mailbox,". Examiner respectfully disagrees with this argument. In col. 1, lines 33-41, Cannon teaches a telephone handset going off-hook and joins the caller's talk path (see col. 5, lines 8-10, 18-22). The teaching of Cannon reads on the claimed "provides a three-way call between the calling party, the called party, and the voice mailbox". It is because, the examiner interprets this limitation as providing call connection from the called party to the voice mailbox and that call connection is bridged to the calling party's call by forming a 3-way call and Cannon teaches such feature on col. 5, lines 8-10, 18-22.

Thus the rejection of the claims in view of Cannon remain.

Applicants respectfully disagree with the Examiner's rejections. The present invention provides a telephone system. In accordance with the present invention, the system includes a switching system for receiving a call from a calling party and a voice mailbox coupled to the switching system for receiving the call if a called party does not answer the call. The system also includes a telephone for receiving the call from the calling party, wherein the telephone provides a three-way call between the calling party, the called party, and the voice mailbox, wherein the telephone bridges the three-way call between the calling party and the voice mailbox, and wherein the telephone is capable of screening the calling party when the calling party is coupled to the voice mailbox. Neither Cannon nor Foladare teach or suggest these features, as discussed below.

Cannon

Cannon discloses a method for screening of an active voice mail message which enables real time monitoring by a subscriber to the voice mail system of incoming calls. Once the identity of the subscriber is established, the subscriber is presented with the option of screening an incoming message. A subscriber desiring to screen the message responds by activating a predetermined key or sequence of keys to enter a listen-only mode for monitoring of the incoming message. The subscriber may then interrupt the message and take the call, continue listening to the incoming message, or terminate listen-only mode and simply permit the message to be stored for later retrieval. (Abstract.)

However, Cannon does not teach or suggest the telephone, wherein the “telephone provides a three-way call between the calling party, the called party, and the voice mailbox, wherein the telephone bridges the three-way call between the calling party and the voice mailbox,” as recited in independent claims 1, 5, 8, and 11.

The Examiner has referred to column 5, lines 8-10 and 18-22 of Cannon as teaching this feature. The Examiner stated that the Examiner interprets Cannon as providing a call connection from the called party to the voice mailbox and that call connection is bridged to the calling party’s call by forming a three-way call. However, column 5, lines 8-10, merely states that the “system remains in listen only mode until the subscriber inputs a predetermined code to interrupt the active message (step 50) and connect to the call (step 52).” Nowhere does this section mention that the subscriber “provides a three-way call.” In fact, this section teaches that the subscriber inputs the predetermined code to “interrupt the active message” and “connect to the call.” This clearly *teaches away* from a “three-way call,” because when the subscriber connects to the call, the active message is already interrupted. Similarly, column 5, lines 18-22, of Cannon merely states that if “the subscriber’s telephone remains in the off-hook state (step 56), listen only mode continues until either the caller or subscriber terminates the call, or the subscriber interrupts the active message and connects to the calling party.” Nowhere does this section mention that the subscriber “provides a three-way call.” This section of also *teaches away* from a three-way

call, because this section also teaches that the “subscriber interrupts the active message and connects to the calling party.”

The Examiner has also asserted that Cannon teaches a telephone handset going off-hook and joins the caller’s talk path, referring to column 1, lines 33-41. This section of Cannon fails to mention a three-way call and merely describes telephone answering device where “when the line being called is busy, the system enables the calling party to leave a message for the called party, who may listen to the message and return the call.”

Therefore, Cannon does not teach or suggest the cooperation of elements as recited in independent claims 1, 5, 8, and 11, and these claims are thus allowable over Cannon.

Foladare

Foladare discloses system and method for providing personal communications services. A bridging and signaling unit implements a bridge for connecting telephone calls between a caller, a called party, and an alternate destination. A caller who calls the personal telephone number associated with a called party is held at the bridging and signaling unit while waiting for a return telephone call from the called party. The called party is alerted to the existence of the call through a paging system. If the time period during which the caller is on hold exceeds a timeout period, the caller will be connected to an alternate destination, such as a secretary, an answering service, or a voice messaging system. If the called party places the return telephone call while the caller is

connected to the alternate destination, the called party will be connected to the caller and the alternate destination in such a manner that the called party can hear the conversation between the caller and the alternate destination, but the caller and the alternate destination cannot hear the called party and do not know that the called party has connected, i.e., the called party is on mute mode. After screening the call, the called party may then indicate that he/she wishes to be connected to the caller, at which time the connection to the alternate destination is terminated and the caller and the called party are connected such that they can speak with each other. If the called party does not wish to speak to the caller, he/she may hang up, and the connection between the caller and the alternate destination may continue. (Abstract.)

However, Foladare does not teach or suggest the telephone, wherein the “telephone provides a three-way call between the calling party, the called party, and the voice mailbox, wherein the telephone bridges the three-way call between the calling party and the voice mailbox,” as recited in independent claims 1, 5, 8, and 11.

The Examiner has referred to column 2, lines 23-30, and column 8, lines 40-57, of Foladare as teaching this feature. However, while column 2, lines 23-30, of Foladare teaches that the called party will be connected to the caller and the alternate destination, nowhere does this section of Foladare teach or suggest that the called party provides this connection. Also, nowhere does column 8, lines 40-57, of Foladare teach that the called party provides bridging. In fact, the Abstract and column 7, line 52, to column 8, line 62 of Foladare describe the

bridging and signaling unit 109 as performing the bridging functions. This clearly teaches away from the telephone of the called party providing a three-way call as in the present invention.

Therefore, Foladare does not teach or suggest the cooperation of elements as recited in independent claims 1, 5, 8, and 11, and these claims are thus allowable over Foladare.

Dependent claims

Dependent claims 2-4, 6-7, 9-10, and 12-14 depend from amended independent claims 1, 5, 8, and 11, respectively. Accordingly, the above-articulated arguments related to claims 1, 5, 8, and 11 apply with equal force to claims 2-4, 6-7, 9-10, and 12-14, which are thus allowable over the cited reference for at least the same reasons as claims 1, 5, 8, and 11.

CONCLUSION

Applicants' attorney believes this application is in condition for allowance. Should any unresolved issues remain, Examiner is invited to call Applicants' attorney at the telephone number indicated below.

Respectfully submitted,

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